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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,147	06/01/2001	Motoki Kato	SONYJP 3.0-185	1948

7590 02/27/2006
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090-1497

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,147	KATO, MOTOKI	
	Examiner	Art Unit	
	HELEN SHIBRU	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 01/23/2006, have been entered and made of record. Claims 29-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 23, 2006.

THE RESTRICTION IS MADE FINAL.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-28 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Regarding claim 19, data structure that does not have any practical application that produces useful, tangible and concrete results are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

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Regarding claims 20-28, data structures not claimed as embodied in computer-readable media, and do not have practical application that produces useful, tangible and concrete results are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hori

(<http://www.w3.org/TR/anot>).

Regarding claim 1, Hori discloses an image coding apparatus comprising:
inputting means for inputting a multiplexed stream containing multimedia coding data
(see abstract and introduction);

separating means for separating a video stream from said input multiplexed
stream (see example);

converting means for performing a predetermined conversion process on said
separated video stream to form a converted video stream (see introduction, paragraph 1-
2);

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generating means for generating additional information indicating that a mismatch will occur when said converted video stream is displayed on the basis of said multimedia coding data (see introduction, paragraph 2); and

outputting means for outputting said converted video stream, said multimedia coding data, and said additional information (see annotation and example).

Regarding claim 2, Hori discloses coding means for coding said additional information generated by said generating means as data separate from said multiplexed stream containing said converted video stream (see introduction paragraph 4 and annotation).

Regarding claim 3, Hori discloses coding means for multiplexing said additional information generated by said generating means with said multiplexed stream containing said converted video stream and then coding a multiplexed result (see introduction paragraphs 2-3).

Regarding claim 4, Hori discloses converting means converts a video stream picture frame parameter (see introduction paragraphs 1-2).

Regarding claim 5, Hori discloses conversion process includes at least a process of decoding said separated video stream and a process of encoding said decoded video stream (see introduction paragraph 1-2).

Regarding claim 6, Hori discloses additional information contains at least one of original picture frame information and an original screen aspect ratio (see introduction paragraph 4 and example).

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Regarding claim 7, Hori discloses additional information generated by said generating means contains an original video format and a video format after said conversion process (see introduction paragraph 2-3 and example).

Regarding claim 8, Hori discloses additional information generated by said generating means contains an original screen aspect ratio and a screen aspect ratio after said conversion process (see introduction paragraph 2 and 4, and example).

Regarding claim 9, Hori discloses additional information contains at least one of information indicating whether a picture frame of said video stream has been converted by said converting means, information about an original picture frame of said separated video stream, and an original screen aspect ratio (see abstract, introduction paragraph 1-2, and 4).

Method claims 10-18 are rejected for the same reason as discussed in apparatus claims 1-9 respectively.

Claims 19 and 20 are rejected for the same reason as discussed in claim 1 above.

Claims 26-28 are rejected for the same reason as discussed in claims 7-9 respectively above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Christopher et al. (US Pat. No. 6,900,845).


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MEHRDAD DASTOURI can be reached on (571) 272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
February 16, 2006


ROBERT CHELINI
PATENT EXAMINER